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EXAMINER
PHILLIPS, HASSAN A

ART UNIT	PAPER NUMBER
2151	

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/941,212	TURNBULL, PAUL F.
	Examiner	Art Unit	
	Hassan Phillips	2151	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **3** MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 August 2001*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage

      application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 2, 6, 7, 10-14, are rejected under 35 U.S.C. 103(a) as being

unpatentable over Mattingly et al. (hereinafter Mattingly), WO 00/17749, in view of

Derwent Abstract Pub. No. RD 413041A, (hereinafter 413').

3. In considering claims 1 and 12, Mattingly teaches: a method of, and a

computer-readable medium comprising computer executable instructions configured for,

upgrading firmware on a computing device comprising: determining a current version of

firmware installed on the computing device, (page 6, lines 5-9); searching a pre-

designated location (260) for a firmware upgrade, (page 6, lines 5-21); sending a

message notification to one or more pre-designated addresses if the firmware upgrade

is found, (page 6, lines 22-25); and installing the firmware upgrade onto the computing

device, (page 6, line 25-page 7, line 8).

Although the disclosed teachings of Mattingly show substantial features of the

claimed invention, they fail to disclose: the message notification being an email

message.

Nevertheless 413' teaches: sending an email notification message to a user when an update is found, (see abstract and Fig. 3).

Thus given the teachings of 413', it would have been obvious to a person of ordinary skill in the art to modify the teachings of Mattingly to show sending an email notification to one or more pre-designated email addresses if the firmware upgrade is found. This would have advantageously notified users on a network when firmware upgrades were available for the computing device, (413' abstract, and Mattingly, page 2, lines 21-27).

4. In considering claim 2, Mattingly further discloses the searching further comprising: comparing the current version of firmware with the firmware upgrade to determine if the firmware upgrade will provide a more recent version of firmware, (page 6, lines 9-21).

5. In considering claim 6, Mattingly further discloses the firmware upgrade occurring automatically when the firmware upgrade is found, (page 3, lines 1-7).

6. In considering claim 7, although the disclosed teachings of Mattingly show substantial features of the claimed invention, they fail to expressly disclose: the pre-designated location being a plurality of pre-designated locations comprising a URL address accessible via the Internet, and a local server address accessible via a local network.

Nevertheless, pre-designated locations comprising URL addresses accessible via the Internet, and local server addresses accessible via local networks were well known in the art at the time of the present invention. 413' teaches: a pre-designated location (17) comprising an address accessible via a network, (see abstract, and Fig. 1).

Thus it would have been obvious to a person of ordinary skill in the art to modify the teachings of Mattingly to show the pre-designated location being a plurality of pre-designated locations comprising a URL address accessible via the Internet, and a local server address accessible via a local network. This would have advantageously provided an alternate means for obtaining the firmware upgrade from a variety of locations, (Mattingly, col. 4, lines 6-2, and 413', abstract).

7. In considering claim 10, Mattingly teaches the computing device being embodied as a device selected from a group of devices comprising: a printer, a scanner, a copier, a facsimile machine, a multifunction peripheral device, a modem, a cellular telephone, a personal computer, and a personal digital assistant (PDA), (page 4, lines 6-12).

8. In considering claim 11, the teachings of Mattingly provide a means for the firmware being device driver software and the firmware upgrade being a device driver upgrade, (page 3, lines 1-7).

9. In considering claim 13, the teachings of Mattingly further provide a means for the computer executable instructions to be further configured to cause a computer to perform the method of claim 1 automatically on a periodic basis, (page 3, lines 1-7).

10. In considering claim 14, the combined teachings of Mattingly (page 3, lines 1-7), and 413' (abstract), provide a means for the computer executable instructions to be further configured to cause a computer to perform the method of claim 1 at the request of a user. One of ordinary skill in the art would combine the teachings of Mattingly with 413' for reasons indicated in considering claims1 and 12.

11. Claims 3, 4, 21, 24-26, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mattingly and 413', in view of Hunt et al. (hereinafter Hunt), U.S. Patent 6,539,422.

12. In considering claim 3, although the disclosed teachings of Mattingly and '413 show substantial features of the claimed invention, they fail to expressly disclose: the searching further comprising initiating a browser application embedded on the computing device.

Nevertheless, in a similar field of endeavor, Hunt teaches: initiating a browser application embedded on a computing device to search for information, (col. 3, lines 39-50).

Thus given the teachings of Hunt, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Mattingly to show the searching further comprising initiating a browser application embedded on the computing device. This would have advantageously provided an alternate means for obtaining the firmware upgrade, (Hunt, col. 4, lines 13-39).

13. In considering claim 4, the teachings of Hunt further provide a means for the browser application to be stored on and executed on a second computing device coupled to the computing device, (col. 4, lines 13-23). One of ordinary skill in the art would combine the teachings of Mattingly and 413' for the same reasons indicated in considering claim 3.

14. In considering claims 21 and 26, Mattingly teaches: a computing device and system for upgrading firmware comprising: firmware stored in nonvolatile memory on the computing device, (page 5, lines 15-19); determining a current version of firmware installed on the computing device, (page 6, lines 5-9); searching a pre-designated location (260) for a firmware upgrade, (page 6, lines 5-21); sending a message notification regarding an available firmware upgrade, (page 6, lines 22-25); and installing the firmware upgrade in the nonvolatile memory, (page 6, line 25-page 7, line 8).

Although the disclosed teachings of Mattingly show substantial features of the claimed invention, they fail to disclose: the message notification being an email message.

Nevertheless 413' teaches: sending an email notification message to a user when an update is found, (see abstract and Fig. 3).

Thus given the teachings of 413', it would have been obvious to a person of ordinary skill in the art to modify the teachings of Mattingly to show sending an email notification regarding an available firmware upgrade. This would have advantageously notified users on a network when firmware upgrades were available for the computing device, (413', abstract, and Mattingly, page 2, lines 21-27).

Although the combined teachings of Mattingly and 413' show substantial features of the claimed invention, they fail to expressly disclose: an applet configured to determine the current version of the firmware.

Nevertheless, applets configured for determining information were well known in the art at the time of the present invention. Hunt teaches: applets configured for determining device data, (col. 7, lines 13-42).

Thus, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Mattingly and 413' to show an upgrade applet configured to determine the current version of the firmware. This would have advantageously added flexibility to the computing device by allowing the computing device to determine the current version of the firmware regardless of device platform, (Hunt, col. 4, lines 24-39).

15. In considering claim 24, Mattingly teaches the computing device being embodied as a device selected from a group of devices comprising: a printer, a scanner, a copier, a facsimile machine, a multifunction peripheral device, a modem, a cellular telephone, a personal computer, and a personal digital assistant (PDA), (page 4, lines 6-12).

16. In considering claim 25, the teachings of Mattingly suggest the nonvolatile memory comprises electrically erasable programmable read-only memory (EEPROM), page 5, lines 5-19.

17. Claims 5, 9, 15-17, 20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mattingly and 413', in view of Sugiarto et al. (hereinafter Sugiarto), U.S. Patent Pub. No. 2002/0143952.

18. In considering claim 5, the combined teachings of Mattingly and 413' further provide a means for: receiving a reply from a recipient of the email notification, (Mattingly, page 6, lines 29-31, and '413, abstract).

Although the disclosed teachings of Mattingly and '413 show substantial features of the claimed invention, they fail to expressly disclose: the email notification comprising a user designated time, and at the user designated time, downloading and installing the firmware upgrade onto the computing device.

Nevertheless, Sugiarto teaches a download timer system and method comprising: a user designating a time to download information onto a computing device, (page 1, paragraph 5).

Thus given the teachings of Sugiarto, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Mattingly and 413' to show the email notification comprising a user designated time, and at the user designated time, downloading and installing the firmware upgrade onto the computing device. This would have advantageously given the user flexibility to decide when the automatic installation of the firmware upgrade should occur (Mattingly, page 3, lines 1-7, and Sugiarto, page 1, paragraphs 5 and 6), as well as given the user the option to select quicker service for a higher price, or delayed service for a discounted price, (Sugiarto, col. 1, paragraph 7).

19. In considering claim 9, the combined teachings of Mattingly and 413' further provide a means for the email notification to comprise: the current version of firmware (Mattingly, page 6, lines 5-9, and 413', abstract); the location of the firmware upgrade (Mattingly, page 6, lines 5-9, and 413', abstract).

Although the disclosed teachings of Mattingly and '413 show substantial features of the claimed invention, they fail to expressly disclose: a selectable option configured to automatically install the firmware upgrade onto the computing device, and information comprising: the cost associated with the firmware upgrade, and billing data required to complete an electronic commerce transaction to purchase the firmware upgrade.

Nevertheless, Sugiarto teaches: a selectable option configured to download content at various times, and information comprising: the cost associated with the content download, and billing data required to complete an electronic commerce transaction to purchase the content download, (page 2, paragraphs 26 and 27).

Thus given the teachings of Sugiarto, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Mattingly and 413' to show the email notification comprising a selectable option configured to automatically install the firmware upgrade onto the computing device, and information comprising the cost associated with the firmware upgrade and billing data required to complete an electronic commerce transaction to purchase the firmware upgrade. This would have advantageously given the user flexibility to decide when the automatic installation of the firmware upgrade should occur (Mattingly, page 3, lines 1-7, and Sugiarto, page 1, paragraphs 5 and 6), as well as given the user the option to select quicker service for a higher price, or delayed service for a discounted price, (Sugiarto, col. 1, paragraph 7).

20. In considering claim 15, Mattingly teaches: a method of upgrading firmware on a computing device comprising: pre-designating a server location (260) to be searched for a firmware upgrade (page 6, lines 5-21); pre-designating an address to which a notification will be sent when the firmware upgrade is found (page 6, lines 22-25); receiving a notification at the address, (page 6, lines 22-25).

Although the disclosed teachings of Mattingly show substantial features of the claimed invention, they fail to disclose: the message notification being an email message.

Nevertheless 413' teaches: sending an email notification message to a user when an update is found, (see abstract and Fig. 3).

Thus, given the teachings of 413', it would have been obvious to a person of ordinary skill in the art to modify the teachings of Mattingly to show sending an email notification to one or more pre-designated email addresses if the firmware upgrade is found. This would have advantageously notified users on a network when firmware upgrades were available for the computing device, (413' abstract, and Mattingly, page 2, lines 21-27).

Although the combined teachings of Mattingly and '413 show substantial features of the claimed invention, they fail to expressly disclose: the email notification comprising a selectable option configured to automatically install the firmware upgrade onto the computing device from a server location.

Nevertheless, Sugiarto teaches: a selectable option configured to download content at various times from a server location, (page 2, paragraphs 26 and 27).

Thus given the teachings of Sugiarto, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Mattingly and 413' to show the email notification comprising a selectable option configured to automatically install the firmware upgrade onto the computing device from the server location. This would have advantageously given the user flexibility to decide when the automatic installation of the

firmware upgrade should occur, (Mattingly, page 3, lines 1-7, and Sugiarto, page 1, paragraphs 5 and 6).

21. In considering claim 16, Sugiarto further teaches in response to a selection of the selectable option, requesting a time at which the download will occur, (page 1, paragraph 5). One of ordinary skill in the art would modify the teachings of Mattingly and 413' with Sugiarto to show in response to a selection of the selectable option, requesting a time at which the firmware upgrade will be automatically installed, for the same reasons indicated in considering claim 15.

22. In considering claim 17, Sugiarto further teaches in response to a selection of the selectable option, requesting billing data required to complete an electronic commerce transaction to purchase content, (page 1, paragraph 5). One of ordinary skill in the art would modify the teachings of Mattingly and 413' with Sugiarto to show in response to a selection of the selectable option, requesting billing data required to complete an electronic commerce transaction to purchase the firmware upgrade, to advantageously give the user the option to select quicker service for a higher price, or delayed service for a discounted price, (Sugiarto, col. 1, paragraph 7).

23. In considering claim 20, the teachings of Mattingly provide a means for the firmware being device driver software and the firmware upgrade being a device driver upgrade, (page 3, lines 1-7).

24. Claim 8, is rejected under 35 U.S.C. 103(a) as being unpatentable over

Mattingly and 413', in view of Nakao et al. (hereinafter Nakao), U.S. Patent Pub. No.

2001/0054152.

25. In considering claim 8, although the disclosed teachings of Mattingly and 413'

show substantial features of the claimed invention, they fail to expressly disclose: the

pre-designated email addresses comprising a plurality of pre-designated email

addresses.

Nevertheless, pre-designated email addresses comprising a plurality of pre-

designated email addresses were well known in the art at the time of the present

invention. Nakao teaches a process for sending image data read out by a scanner to a

customer of a user in the form of an email wherein: the user selects a pre-designated

email address or a plurality of pre-designated email addresses to send the image data

to, (page 9, paragraph 220).

Thus it would have been obvious to a person of ordinary skill in the art to modify

the teachings of Mattingly and 413' to show the pre-designated email addresses

comprising a plurality of pre-designated email addresses. This would have

advantageously allowed for more than one user at a time to be notified of firmware

upgrades, (Nakao, page 9, paragraph 220).

26. Claims 18, 19, 22, 23, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mattingly, 413', Sugiarto, and Hunt.

27. In considering claim 18, although the combined teachings of Mattingly, 413' and Sugiarto show substantial features of the claimed invention, they fail to expressly disclose: the pre-designating a server comprising configuring an applet on the computing device with an address location on the server.

Nevertheless, configuring applets on computing devices with address locations of servers was well known in the art at the time of the present invention. Hunt teaches: configuring applets on computing devices (110, 120) with address locations of servers (100), (col. 7, lines 13-42).

Thus, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Mattingly, 413' and Sugiarto to show the pre-designating a server comprising configuring an applet on the computing device with an address location on the server. This would have advantageously allowed for the computing device to access the server over a network regardless of server/device platform, (Hunt, col. 4, lines 24-39).

28. In considering claim 19, although the combined teachings of Mattingly, 413' and Sugiarto show substantial features of the claimed invention, they fail to expressly disclose: configuring an applet for receiving a notification.

Nevertheless, configuring applets for receiving notifications was well known in

the art at the time of the present invention. Hunt teaches: configuring applets on

computing devices (110, 120) for receiving notifications, (col. 7, lines 13-42).

Thus, it would have been obvious to a person of ordinary skill in the art to modify

the teachings of Mattingly, 413' and Sugiarto to show the pre-designating an email

address to comprise configuring an applet on the computing device with an email

address for receiving an email notification. This would have advantageously allowed for

the computing device to receive the email notifications over a network regardless of

server/device platform, (Hunt, col. 4, lines 24-39).

29. In considering claim 22, the combined teachings of Mattingly and 413' further

provide a means for the email notification to comprise: the current version of firmware

(Mattingly, page 6, lines 5-9, and 413' abstract); the location of the firmware upgrade

(Mattingly, page 6, lines 5-9, and 413' abstract).

Although the disclosed teachings of Mattingly and '413 show substantial features

of the claimed invention, they fail to expressly disclose: a selectable option configured to

have the available firmware upgrade installed at a user-designated time.

Nevertheless, Sugiarto teaches: a selectable option configured to download

content at a user-designated time, (page 2, paragraphs 26 and 27).

Thus given the teachings of Sugiarto, it would have been obvious to a person of

ordinary skill in the art to modify the teachings of Mattingly and 413' to show the email

notification comprising a selectable option configured to have the available firmware

upgrade installed at a user-designated time. This would have advantageously given the

user flexibility to decide when the installation of the firmware upgrade should occur

(Sugiarto, page 1, paragraphs 5 and 6).

30. In considering claim 23, Sugiarto further teaches: information comprising: a

cost associated with an available content download (page 2, paragraphs 26 and 27);

and billing data required to complete an electronic commerce transaction to purchase

the available content download (page 2, paragraphs 26 and 27). One of ordinary skill in

the art would modify the teachings of Mattingly and 413' with Sugiarto to show the

email notification further comprising: information comprising: a cost associated with an

available firmware upgrade; and billing data required to complete an electronic

commerce transaction to purchase the available firmware upgrade, to advantageously

give the user the option to select quicker service for a higher price, or delayed service

for a discounted price, (Sugiarto, col. 1, paragraph 7).

Furthermore, the combined teachings of Mattingly, 413', Sugiarto and Hunt

provide a means for the selectable option to comprise: a second applet configured to

browse to the pre-designated location and install the available firmware upgrade upon

completion of the electronic commerce transaction, (Mattingly, page 6, lines 5-21, 413'

abstract, Sugiarto, page 2, paragraphs 26 and 27, and Hunt, col. 7, lines 13-42). One of

ordinary skill in the art would modify the teachings of Mattingly with 413', Sugiarto, and

Hunt for the same reasons previously indicated in considering claims 21 and 22.

Conclusion

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hassan Phillips whose telephone number is (571) 272-3940. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HP/
8/25/05

ZARNI MAUNG
SUPERVISORY PATENT EXAMINER